

### Remarks

In the instant Office Action dated December 18, 2008, the Examiner has indicated that claims 6-7 and 18-19 are objected to but would be allowable if rewritten in independent form. Claims 1-5 and 9-17 stand rejected under 35 U.S.C. § 103(a) over Sanford (US Patent No. 6,424,300) in view of Chang (U.S. Patent No. 5,142,255); and claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) over the Sanford '300 and Chang '255 references in view of Schamberger (U.S. Patent Pub.. 2003/0117331). Applicant traverses the rejection and, as should be apparent, Applicant does not acquiesce to any objection, rationale or averment made in the Office Action.

The § 103(a) rejection over Sanford in view of Chang is improper for failure to present a *prima facie* case on correspondence to the asserted teachings and an articulated nonconclusory basis for asserting that the skilled artisan would implement the combination. In connection with this rejection, Applicant submits that the rejection cannot be maintained because it does not satisfy the requirement of correspondence to the asserted teachings and it does not satisfy the requirement of providing an articulated nonconclusory basis for asserting that the skilled artisan would implement the combination.

The Office Action's deficiencies with respect to both lack of correspondence and lack of motivation for combining are apparent from a careful review of the record. The Office Action acknowledges that the Sanford '300 reference does not teach the invention as a whole (*e.g.*, with no teaching of at least the last three lines of claim 1 involving deactivation of the notch antenna), and a careful review of Chang reveals that it fails to teach or suggest any way for controlling or deactivating the notch antenna of the Sanford '300 reference. Rather, as pointed out elsewhere in the Office Action, Chang teaches controlling or deactivating its active notch antenna by using a relatively complex "Varactor-tuned active notch antenna and GaAs FET with shorted end permitting gate of the GaAs FET to switching de-activating/activating notch antenna" as shown in Chang's Figures 1, 14 and 26-28 (see Office Action at p.3). The Office Action has attempted to support the rejection by combining the Chang switching function (via the Chang switching circuit for de-activating/activating notch antenna) with the overall teaching of Sanford and thereby constructing functionality, which would seem to be similar to Applicant's invention.

The Office Action, however, does not recognize that the Chang switching circuit for de-activating/activating notch antenna is entirely incompatible with, and not at all useful (conceptually or practically) for controlling or deactivating, the notch antenna of the Sanford '300 reference. Simply put, the notch antenna of the Sanford '300 reference is a passive notch antenna whereas Chang's notch antenna is an active notch antenna; attempting to use the Chang switching circuit for de-activating/activating the passive notch antenna would render the notch antenna of the Sanford '300 reference inoperable.

Accordingly, neither correspondence nor motivation is presented by the combination of asserted prior art teachings. These teachings do not provide any correspondence to the last aspects of Applicant's claimed invention because the Chang switching circuit cannot be used to overcome the deficient teachings of the Sanford '300 reference for the Examiner's rejection. These teachings are not motivated because any inoperable combination teaches away and is improper as explained in the M.P.E.P. at § 2143. More particularly, consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a §103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('300) reference --the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007).

Also based on lack of correspondence and motivation, the rejections of the dependent claims are also illogical. For example, claims 5, 10 and 17 are directed to the apparatus of the underlying independent claim where capacitance means are connected across the notch for tuning the notch antenna and in that the circuitry for de-activating the notch antenna comprises means for shorting the capacitance means. The Chang switching circuit also cannot be used for de-activating/activating the passive notch antenna as set forth in claim 5, or in any manner connected across the prior art notch, without rendering the notch antenna of the Sanford '300 reference inoperable. Moreover, the Office Action appears to admit in connection with the rejection of claim 1 that the Sanford '300 reference does not teach the claimed deactivating circuit and then, when rejecting each of these claims as part of the underlying independent claim, the Office Action attempts to support the rejection by citing to figures from the Sanford '300 reference; this rejection is contradicting and cannot be maintained.

The rejection of claims 8 and 20 is also improper and cannot be maintained. The Schamberger reference does not teach or suggest any circuit whatsoever that is configured for measuring the contemporaneous quality of such signals. Figures 3 and 4 of the Schamberger reference are merely testing results performed on the circuits shown in the earlier figures.

The amendments to claims 3, 10 and 13 (adding the word "passive") is supported by Applicant's original specification, *e.g.*, as illustrated by the figures.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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